

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 2

claims 34-38 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,455,409 issued to Smith et al. and U.S. Patent No. 4,376,936 issued to Kott.

As discussed further below under the corresponding headings, Applicants submit that (1) the restriction requirement is improper and must be withdrawn, (2) it is improper to deem that Applicants have constructively elected to prosecute a group of claims in a new restriction requirement based upon an election in a prior restriction requirement that was subsequently withdrawn, and (3) claims 34-38 are allowable over the teachings of Smith et al. and Kott.

The Restriction Requirement Is Improper

As the Examiner is well aware, this application is a continuation of U.S. Patent Application No. 08/379,944. In that parent application, a six-way restriction requirement was made. After convincing the Examiner to join two of the identified groups, Applicants elected and prosecuted the two rejoined groups. Having obtained allowance of some of the claims of the two elected groups in the parent application, Applicants canceled the rejected claims from the parent application so that the allowed claims could issue in a patent at an earlier date than if those claims were maintained in an application in which the rejected claims were appealed.

The claims now presented in this application were thus included in one common group of elected claims of the parent application. During prosecution of the parent application, the Examiner had prepared and mailed several Office Actions in which all of the claims pending in this application had been examined and rejected. Despite the fact that the Examiner had already examined all the claims pending in this application several times during the prosecution

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 3

in the parent application, the Examiner required restriction of these claims into eight different groups in an Office Action mailed on June 8, 1998. After the Examiner refused to withdraw the restriction requirement at Applicants' request, Applicants petitioned the group director to withdraw the restriction requirement. The group director responded by withdrawing the restriction requirement in its entirety. Now, in the latest Office Action, the Examiner has made a new restriction requirement restricting the claims into six different groups. The restriction requirement as set forth in the latest Office Action is as follows:

<u>Group</u>	<u>Claims</u>
I.	1-6 and 23-33
II.	1, 7-10, 19, 61, and 62
III.	1, 11-13, and 39-41
IV.	14-18, 20-22, 53-60, and 63
V.	42-52
VI.	34-38

In the Office Action, the Examiner states that groups I through VI are related to one another as subcombinations disclosed as usable together in a single combination.

It is evident from the Office Action that the Examiner has a fundamental misunderstanding of when it is proper to restrict amongst subcombinations. The Examiner appears to use a standard by which one only looks at the two subcombinations and determines whether one of the subcombinations has a separate utility from the other subcombination.

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 4

However, this is not the proper standard for making a restriction requirement between two subcombinations. MPEP §806.05(d) states:

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The examiner must show, by way of example, that one of the subcombinations has utility other than *in the disclosed combination*. Care must be taken to determine if the subcombinations are generically claimed.

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP §804(b)). [Emphasis added]

Thus, the standard is not whether one of the subcombinations has a different utility than the other subcombination, but rather whether one of the subcombinations has a utility different from the disclosed combination, which inherently includes each of the recited elements of both subcombinations.

yes
no
msg/
In presenting reasons for restricting inventions I and II, the Examiner states that invention I has separate utilities such as "leading a human to the location of the folder." Applicants presume the Examiner is referring to the indicator located on one of the file folders as recited in dependent claim 2. The *disclosed combination* of the subcombination of inventions I and II necessarily includes the indicator as recited in claim 2. Accordingly, invention I (which includes claim 2) would not have separate utility than the disclosed combination, since it also necessarily includes the recited indicator. Accordingly, the Examiner has failed to meet the burden of providing an example by which the subcombination would be separately useable from the *disclosed combination*, and accordingly, a proper basis for restricting inventions I and II has not been provided.

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 5

It is further noted that both inventions I and II include claims that depend from independent claim 1. The Examiner has indicated that claim 1 would be included with any of groups I through III. It is therefore apparent that independent claim 1 is generic to at least some of the claims defining inventions I and II. As stated in the above-quoted portion of MPEP §806.05(d), when subcombinations are both species under a claim genus and related, then the Examiner must apply the practice applicable to both election of species and the practice applicable to related inventions. MPEP §806.05(d) further points out that if restriction is improper under either practice, it should not be required. In the present case, claims 2-6 represent a species of generic claim 1, while claims 7-10 represent a different species of generic claim 1. The inventions defined in these claims are related, since they are both usable together in the disclosed combination. Accordingly, the Examiner must apply both practices for subcombinations and for an election of species. As indicated above, inventions I and II are not properly restricted based on the practice pertaining to related inventions (subcombinations). Additionally, the restriction is improper because the Examiner has not applied the practice pertaining to an election of species, and because that practice would indicate that the restriction is improper.

For such a restriction of species to be proper, it is incumbent upon the Examiner to show that each of the species claims defines characteristics of the invention that are mutually exclusive of one of the characteristics defined in the other species claims. MPEP §806.04(e) defines "species" as follows:

Species are always the specifically different embodiments.

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 6

Species are *usually* but not always independent as disclosed (see MPEP §806.04(b)) since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any commonality of operation, function or effect.

Most significantly, MPEP §804.04(f) states:

Claims to be restricted to different species **must be mutually exclusive**. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that the claims to be restricted to different species, must recite the mutually exclusive characteristics of such species.

As explained below, the alleged "species" claims restricted into different groups do not define mutually exclusive characteristics of the invention. In fact, the specification clearly teaches that all the recited characteristics may be found in a single system constructed in accordance with the present invention. Fig. 1 clearly shows a system including most, if not all, of the different types of disclosed folder retainers that may be used in the inventive system.

With respect to the restriction between inventions I and III, the Examiner contends that invention I has separate utilities, such as locating a file using over-the-air signaling. It is noted that the claims of invention III do not exclude the use of over-the-air signaling. Claim 11, for example, recites the structure of a file folder, claim 12 recites the structure of a folder retainer, and claims 39-41 recite details of the file folder construction. As disclosed in the application and specifically as shown in Fig. 15, file folders having the constructions noted above and claimed, as well as folder retainers having the claimed structure, may be used in a system that employs over-the-air signaling. Note that file cabinet 50, tray 40, desk 85, and bookshelf 60

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 7

include conductive rails that contact conductive rails on a file folder. Because both subcombinations would enjoy the same use, the Examiner has not shown separate utility from the disclosed combination. Furthermore, because the features claimed in inventions I and III are not mutually exclusive from one another, and because the claims of inventions I and III depend upon a common generic claim (claim 1), restriction is improper because the practice relating to an election of species would apply, but the requirements would not be met. Accordingly, the restriction requirement between inventions I and III is improper and must be withdrawn.

With respect to inventions I and IV, the Examiner states that invention I has separate utility, such as locating a loose folder not physically connected to another element. As shown in Fig. 15, the *disclosed combination* of folder retainers that include conductive rails and file folders that include indicators, allows the location of file folders that are not necessarily in physical contact with any other element. Thus, the separate utility the Examiner suggests is not found in the *disclosed combination*. It is noted that the claims of group IV do not require that all folder retainers include such conductive rails or that all file folders include such conductors for contacting the conductive rails.

In addition, it is pointed out that claims 14-18 of invention group IV depend from claim 12 of group III, which depends from generic independent claim 1, as do claims 2-6 of invention group I. Because of the presence of this generic claim and because inventions I and IV are related, the practice applicable to election of species must be applied. Here again, as clearly shown in Fig. 15, the two concepts are not mutually exclusive, and therefore, the

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 8

practice under election of species dictates that the restriction requirement is improper for this additional reason. Accordingly, the restriction between invention groups I and IV is improper and must be withdrawn.

It is also noted that if claim 1 or 12 is allowed, claims 14-18 of group IV would also be allowable and would need to be rejoined with the groups in which claim 1 and 12 are included.

With respect to inventions I and V, the Examiner contends that invention I has separate utilities, such as locating or indicating to a human the location of a file. Again, as indicated above with respect to the restriction between inventions I and II, the disclosed *combination* includes the indicator that is recited in claims 2-6. Accordingly, the subcombination of invention I would not have such separate utility, and accordingly, the restriction between inventions I and V is improper and must be withdrawn.

With respect to inventions I and VI, the Examiner states that invention I has separate utilities, such as locating or indicating to a human with over-the-air signals. Again, the disclosed combination includes the indicator recited in the claims that define invention I, and therefore, this does not constitute a separate utility for the subcombination of invention I. Furthermore, concerning the use of over-the-air signals, independent claim 34 of invention group VI does not disclose any differing physical electrical connection structure that is not included in independent claim 1, which forms part of invention group I. Thus, there is simply no separate utility in this regard.

For the reasons stated above, invention groups I and VI are not properly restricted, and the restriction requirement should therefore be withdrawn.

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 9

With respect to inventions II and III, the Examiner states that invention group III has separate utility, such as reading information from a storage media on the file (equal to the file contents). Applicants do not understand what the Examiner is referring to. Claims 11-13 of invention group III refer to the conductive rails of a folder retainer and the conductors provided on a surface of the file folders. Nowhere in these claims is there any reference to any information that can be read from a storage media on the file. Accordingly, invention III would not have such separate utility, since such utility is not even found in all the claims of this invention group. Thus, the restriction between inventions II and III is improper and should be withdrawn.

Regarding inventions II and IV, the Examiner states that invention IV has separate utility, such as writing data to a storage media on the file from a standalone data writer. Again, Applicants do not understand where the Examiner considers such utility to come from, since claims 14-18, which form a part of invention group IV, do not recite anything to do with a storage media, a data writer, or writing data to any such storage media. Likewise, invention II includes claims that do not recite any such feature. For example, claim 8 merely recites that the processor is a personal computer. Therefore, the restriction of groups II and IV is improper and should be withdrawn. It is also noted that claims 61 and 62 of group II depend from independent claim 54 of group IV. Accordingly, if claim 54 is allowed, claims 61 and 2 and the other claims of group II must be rejoined with the claims of group IV, because claims 61 and 62 would inherently be allowable.

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 10

With respect to inventions II and V, the Examiner states that invention V has separate utility, such as monitoring who has worked on a particular file. Because the disclosed *combination* inherently includes the same features that are recited in the claims of invention V, the disclosed combination would have the same utility. Accordingly, the Examiner has not met his burden for providing a separate utility for the subcombination from the disclosed combination. Accordingly, the restriction between inventions II and V is improper and should be withdrawn.

With respect to inventions II and VI, the Examiner states that invention II has separate utilities, such as interacting file information to provide data about the file to various locations on a LAN. It is believed that the Examiner is referring to the features recited in claim 9, which recites that the processor is a computer coupled to a computer network. Again, the disclosed combination includes this feature, and hence, the Examiner has failed to show a separate utility for the subcombination apart from the disclosed combination. The restriction between inventions II and VI is therefore improper and must be withdrawn.

With respect to inventions III and IV, the Examiner contends that invention III has separate utility, such as connecting file electronics to a data writer for storing information on a file. None of claims 11-13, which form a part of invention group III, however, recite any such function or structure pertaining to a data writer for storing information on a file. Furthermore, it is not clear that the disclosed combination would not also have the same utility. The restriction requirement between inventions III and IV is improper and must be withdrawn.

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 11

With respect to inventions III and V, the Examiner states that invention III has separate utility, such as connecting file electronics to a data writer for storing information on an electronic portion of a file. Again, for the reasons stated above with respect to inventions III and IV, there are claims in invention group III that do not recite any such structure, and the disclosed combination would inherently have this same utility. The restriction between inventions III and V is therefore improper and must be withdrawn. It is also noted that claims 39-41 of group III depend from independent claim 38 of group V. Accordingly, if claim 38 is allowed, claims 39-41 must also be allowed and thus rejoined along with the other claims of group III, with group V.

With respect to inventions III and VI, the Examiner again states that invention III has separate utility, such as connecting file electronics to a data writer for storing information on an electronic portion of a file. Because invention group III does not recite any such feature or structure and because the disclosed combination would inherently include this same utility if, in fact, it is found in invention group III, the restriction between inventions III and VI is improper and must be withdrawn.

Regarding inventions IV and V, the Examiner states that invention IV has separate utility, such as to "store files requiring power to maintain data." Claims 14-18, which form a part of invention IV, do not recite any structure pertaining to the storage of data, nor do they include any features relating to non-volatile memory. Thus, it is not at all clear where this utility comes from, nor is it clear that the disclosed combination would not also include this

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 12

utility. Accordingly, the restriction between inventions IV and V is improper and should be withdrawn.

Regarding inventions IV and VI, the Examiner states "invention IV has separate utility such as store files requiring power to maintain data." For the reasons stated above with respect to the restriction between inventions IV and V, Applicants submit that the restriction requirement of inventions IV and VI is improper and must be withdrawn.

With respect to inventions V and VI, the Examiner states "invention V has separate utility such as providing information on who has had the file last." To the extent that the claims of invention V recite specific features pertaining to tracking who had the file last, the disclosed *combination* would inherently also include this feature and hence have this same utility. Because no separate utility has been shown for the subcombination apart from the disclosed combination, the restriction between inventions V and VI is improper and must be withdrawn. It is also noted that claim 42 of group V depends from independent claim 34 of group VI. Thus, if claim 34 is allowed, claim 42 must also be allowed, and therefore, claim 42 along with the other claims of group V would have to be rejoined with the claims of group VI.

Because the claims of all of groups I through VI are so intertwined by their dependence on one another, and because the Examiner has already issued Office Actions in the parent application that treat all the claims on their merits, Applicants submit that there would be no significant additional burden on the Examiner simply to examine all of the claims at once in this single application.

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 13

Thus, for the reasons stated above, each of the restriction requirements between the inventions of groups I through VI are improper and must be withdrawn.

Improper Invocation of Constructive Election

For the reasons stated below, Applicants submit that the Examiner has improperly invoked the constructive election doctrine to presume that Applicants have elected a particular claim group presented for the first time in this restriction requirement based upon the election of a group of claims in a restriction requirement that was subsequently withdrawn. Specifically, the Examiner contends that because Applicants had previously elected the group of claims that included claims 34-38, the elected invention for purposes of response to this later restriction requirement would be invention group VI, since it also includes claims 34-38.

First, Applicants ask the Examiner to provide his authority for this presumptive election. Typically, such constructive elections only occur when an applicant has actually elected one of the claim groups in which the application has been restricted. Here, there was no outstanding election, since the prior restriction requirement had been withdrawn.

Lastly, Applicants inquire why group VI was now constructively elected when the group of claims that Applicants had previously elected included not only claims 34-38, but also included claims 1, 12, 13, 19, 23, and 54. As it turns out, it is claims 1, 12, and 13 that are of greatest interest to Applicants at this particular time. These claims were part of the previously elected group VII, in addition to claims 34-38. Thus, it is not logical to imply that Applicants

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 14

had intended to pursue the most recent invention group VI instead of pursuing invention group III, which includes claims 1, 12, and 13.

Insofar as the Examiner's presumptive election is improper, Applicants hereby wish to respond to the restriction requirement by electing group III with traverse.

Claims 34-38 Are Allowable over Smith et al. and Kott

Although Applicants have not elected the group including claims 34-38, Applicants will nevertheless take this opportunity to respond to the rejection of these claims for purposes of filing a complete response to the Office Action. It is noted that the Examiner had previously indicated that claims 35, 36, and 38 recite allowable subject matter, which prompted Applicants to rewrite claims 35-38 in independent form and pay the additional \$234 fee. Now, however, the Examiner has rejected claims 35-38 along with independent claim 34. For the reasons stated below, Applicants respectfully traverse the rejection.

not

In the Office Action on page 11, the Examiner states that the limitation "when the file folder is positioned in **any one of** several different positions" may be interpreted when a file folder is in only one position while still allowing communication. The Examiner contends that the Kott reference teaches such a feature.

Claim 34, as amended, recites that the conductor on the file folders is located on the file folder and configured so as to electrically couple the addressable device to the electrical contacts of the folder retainer "when said file folder is positioned in *each* of several different positions." Claim 35, as amended, recites "when said file folder is positioned in *each* of

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 15

several different orientations with respect to the electrical contacts." Claim 36, as amended, recites "when said file folder is positioned in *each* of several different positions with respect to an adjacent file folder." Claim 37 depends from claim 36. Claim 38 recites "for at least one file folder, said conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer at a plurality of locations *on said file folder*."

With respect to claims 34-37, the claims can no longer reasonably be interpreted to read on a file folder that is placed in only one position or orientation. With respect to claim 38, which has not been amended, Kott does not disclose a conductor that is located on a file folder and is configured to electrically couple an addressable device on the file folder to the electrical contacts of a folder retainer at more than one location *on the file folder*. The Kott file folder only includes one contact location.

Because neither Kott nor Smith et al. teaches or suggests such features, Applicants submit that claims 34-38 are in condition for allowance. Applicants further point out that claims 39-41 depend from allowable claim 38, while claim 42 depends from claim 34. Therefore, in the event the Examiner decides not to withdraw any of the restriction requirements or otherwise allow Applicants to pursue invention group III, claims 39-42 at least should be regrouped and allowed along with the claims from which they depend. Further, to the extent that the application would then include claims from invention groups III, V, and VI, the Examiner should consider rejoining at least those groups along with claims 39-42. If these groups are not then rejoined within this application, Applicants would then be presenting those invention groups in divisional applications that could not be subjected to a double-patenting

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 16

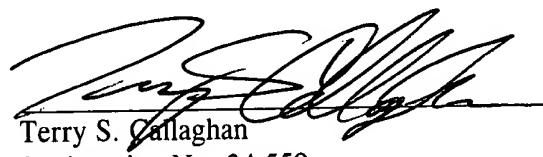
rejection despite the fact that there would be claims from both groups III and V in two different applications.

In view of the foregoing amendments and remarks, Applicants submit that the restriction requirement as presented is improper and that the presumptive election made by the Examiner of invention group VI is also improper, and that if any restriction is maintained, Applicants' election of invention group III should be permitted. Applicants also submit that claims 34-38 are in condition for allowance. The Examiner's reconsideration and timely allowance of the claims is requested. A Notice of Allowance is therefore respectfully solicited.

Respectfully submitted,

JOEL D. STANFIELD ET AL.

By: Price, Heneveld, Cooper,
DeWitt & Litton



Terry S. Callaghan
Registration No. 34 559
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
616-949-9610

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Date

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